



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,924	04/26/2001	Craig S. Skinner	PALM-3609.US.P	8278

7590 03/01/2005
WAGNER, MURABITO & HAO LLP
Third Floor
Two North Market Street
San Jose, CA 95113

EXAMINER

COLIN, CARL G

ART UNIT	PAPER NUMBER
----------	--------------

2136

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/844,924	Applicant(s) SKINNER, CRAIG S.	
	Examiner Carl Colin	Art Unit 2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. In response to communications filed on 11/23/2004, applicant amends claims 5,13, 20, 24. The following claims 1-31 are presented for examination.

1.1 The amendments to the specification, pages 3-5, filed on 11/23/2004 have been considered, but the amended abstract reads “the a method”. Therefore, the abstract is still objected to correct this minor error.

2. Applicant’s remarks, pages 19-26, filed on 11/23/2004, with respect to the rejection of claims 1-31 have been fully considered, but they are not persuasive. The independent claims have been amended to recite wherein said first authorization level authorized said electronic device to run controlled applications having authorization levels not exceeding said first authorization level and wherein a second authorization level of said controlled application does not exceed the first authorization level. Applicant argues that the reference does not teach this amended limitation. Beetcher discloses that each customer receives an entitlement key enabling the customer to run only those software modules to which he is entitled (column 4, lines 40-45) Beetcher adds the version specified in the entitlement key will entitle device to run software at that version level and all previous levels” (column 6, lines 26-31) that also reads the amended limitation wherein said first authorization level authorized said electronic device to run controlled applications having authorization levels not exceeding said first authorization level. Beetcher citation clearly reads the claimed limitation. Also the secondary reference discloses an

Art Unit: 2136

authorization level similar to Applicant's description. Therefore, applicant has not overcome the rejection and the claims remain rejected on the same ground of rejection.

Specification

2. The specification is objected to because the amended abstract reads "the a method".

Therefore, the abstract is still objected to correct this minor error.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3.1 **Claims 1-6, 8-9, 12-25, 27-28, and 31** are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,933,497 to **Beetcher et al.**

3.2 **As per claims 1 and 20, Beetcher et al.** discloses a method of security comprising the steps of: enabling a computer system to execute a software module with an encrypted entitlement key containing at least a machine serial number and version number that indicates sufficient authority to execute that meets the recitation of a) enabling an electronic device to run a controlled application with an encrypted record containing a copied serial number and a first authorization level, for example (see column 6, lines 20-67); **Beetcher et al.** discloses that each

Art Unit: 2136

customer receives an entitlement key enabling the customer to run only those software modules to which he is entitled (column 4, lines 40-45) that meets the recitation of wherein said first authorization level authorized said electronic device to run controlled applications having authorization levels not exceeding said first authorization level. **Beetcher et al.** adds the version specified in the entitlement key will entitle device to run software at that version level and all previous levels" (column 6, lines 26-31) that also reads the amended limitation wherein said first authorization level authorized said electronic device to run controlled applications having authorization levels not exceeding said first authorization level; b) verifying said electronic device is correctly enabled, for example (see column 6, line 65 through column 7, line 47); and c) verifying said first authorization level is of sufficient authority to run said controlled application on said electronic device, for example (see column 6, line 65 through column 7, line 47 and column 8, lines 22-52); and wherein a second authorization level of said controlled application does not exceed the first authorization level (column 6, lines 26-31).

As per claims 2, 14, and 21, Beetcher et al. discloses the limitation of wherein step a) comprises the steps of: a1) fetching a serial number uniquely associated with said electronic device, said serial number located on said electronic device, for example (see column 7, line 47); a2) copying said serial number, forming said copied serial number that is identical to said serial number, for example (see column 6, lines 20-40); a3) creating a record that contains said copied serial number and said first authorization level, said first authorization level previously assigned to said electronic device, for example (see column 6, lines 20-40); a4) encrypting said record, forming said encrypted record, for example (see column 4, lines 57-65 and column 8, lines 53-

Art Unit: 2136

65); and a5) storing said encrypted record in said electronic device, for example (see column 8, lines 53-65).

As per claims 3 and 22, Beetcher et al. discloses the limitation of wherein step b) comprises the steps of: b1) locating said encrypted record, for example (see column 9, line 40 through column 10, line 20); b2) decrypting said encrypted record, if said encrypted record is located, for example (see column 9, line 40 through column 10, line 20); b3) reading said copied serial number from said encrypted record, if said encrypted record is successfully decrypted; b4) fetching said serial number, for example (see column 9, line 40 through column 10, line 20); and b5) comparing said serial number and said copied serial number, for example (see column 9, line 40 through column 10, line 20 and column 13, lines 1-8).

As per claims 4 and 23, Beetcher et al. discloses the limitation of wherein step b) comprises the further step of executing said controlled application on said electronic device, said controlled application having controlled attributes, for example (see column 6, lines 40-67);

As per claims 5, 12, 24, and 31, Beetcher et al. discloses the limitation of wherein said step c) comprises the steps of: c1) reading said first authorization level from said encrypted record that is decrypted, if said serial number and said copied serial number match, for example (see column 9, lines 40-67 and column 10, lines 20-67); c2) comparing said first authorization level with a second authorization level assigned to said controlled application; and c3) allowing access to said controlled attributes of said controlled application, if said first authorization level

Art Unit: 2136

is of an equal or higher authorization level than said second authorization level, for example (see column 8, lines 48-67 and column 4, lines 34-46).

As per claims 6, 15, and 25, Beetcher et al. discloses the limitation of wherein step a) is performed with object code instructions that meet the recitation of an enabler application, said enabler application enabling said electronic device to run applications having authorization levels equal to or lower than said first authorization level, for example (see column 8, lines 48-67 and column 4, lines 34-46).

As per claims 8, 9, 18, 19, 27, and 28, Beetcher et al. discloses the limitation of comprising the further step of: aborting said application and denying access if any of the following conditions are met: said encrypted record is not successfully located in step b1) ; said encrypted record is not successfully decrypted in step b2); said serial number and said copied serial number do not match in step b5); or said first authorization level is of a lesser value than said second authorization level in step c2) , for example (see column 8, lines 48-67 and column 4, lines 34-46 and column 10, lines 20-67).

Claims 13 and 16 contain some of the limitations of the rejected **claims 1-5**. Therefore, **claims 13 and 16** are rejected on the same rationale as the rejection of **claims 1-5**.

Art Unit: 2136

As per claim 17, **Beetcher et al.** discloses the limitation of wherein the same encryption/decryption protocol is used in performing steps c) and m), for example (see column 13, lines 5-18).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4.1 **Claims 7, 10-11, 26, and 29-30** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,933,497 to **Beetcher et al.** in view of US Patent 6,526,512 to **Siefert et al.**

4.2 As per **claims 7 and 26, Beetcher et al.** substantially teaches the claimed method of claims 6 and 25. **Beetcher et al.** does not explicitly teach removing said enabler application from said electronic device after successfully completing step a). However, **Siefert et al.** in an analogous art teaches control access to enhance security of resources where a match

Art Unit: 2136

determination process can take actions of erasing part or all of the program to defeat running of the program, for example (see column 7, lines 35-40). **Siefert et al.** also adds, hiding process/codes or removing or placing them in separate memory or non-accessible memory locations can prevent hackers to trace the logic of codes, for example (see column 7, line 40 through column 8, line 5). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of **Beetcher et al.** to remove said enabler application from said electronic device after successfully completing step a) as taught by **Siefert et al.** This modification would have been obvious because one skilled in the art would have been motivated by the suggestions provided by **Siefert et al.** so as to make the security process non accessible to hackers, for example (see column 7, line 40 through column 8, line 35).

As per claims 10-11 and 29-30, **Beetcher et al.** discloses locking in memory the version number the product number, serial number etc. and also discloses codes stored in read-only memory (ROM) to make it not capable of alteration by customers, for example (see column 7, lines 15-30 and column 9, lines 49-67). It is well known in the art of computer security that computers have flash memory and using a flash memory will not depart from the spirit and scope of the invention of **Beetcher et al.** **Siefert et al.** also discloses using read-only memory (ROM) for the encrypted data and serial number. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to store said encrypted record and serial number in locked flash record in said electronic device as suggested by **Beetcher et al.** to prevent alteration of these data by customers.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

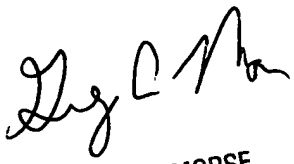
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

5.1 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 571-272-3862. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

cc
Carl Colin
Patent Examiner
February 21, 2005


GREGORY MORSE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100